

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION
OF: ROSENBERG ET AL.
SERIAL NO. 10/539,505
FILED: JANUARY 01, 2006
FOR: FORMULATION COMPRISING FENOFIBRIC ACID, A PHYSIOLOGICALLY ACCEPTABLE SALT OR DERIVATIVE THEREOF

DOCKET NO.: M/43212-US-1
CONFIRMATION NO.: 4705
GROUP ART UNIT: 1621
EXAMINER: J. Y. CHO

Honorable Commissioner
for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

S U B M I S S I O N

Sir:

Applicants herewith enclose an Office action, mailing date November 15, 2006, which appears to have issued in error. Although the cover page of the Office action specifies the above-identified application, page 2 et seq. pertain to *Serial No. 10/007,312 of Hoffmann et al.* rather than the above identified case. It is also respectfully noted that an Office action pertaining to the above-identified application was mailed on October 05, 2006.

It is respectfully requested that the Office clarify the situation, and that the records of the above-identified application be corrected as necessary. Favorable action is solicited.

Please charge any shortage in fees due in connection with the filing of this paper, including Extension of Time fees, to Deposit Account No. 14.1437. Please credit any excess fees to such deposit account.

Respectfully submitted,
NOVAK DRUCE DELUCA & QUIGG

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Encl.: Office action dated November 15, 2006 (original)

JR/BAS



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,505	01/09/2006	Joerg Rosenberg	M/43212-US-1	4705
26474	7590	11/15/2006	RECEIVED NOV 17 2006 NOVAK DRUCE - DC	EXAMINER CHO, JENNIFER Y
NOVAK DRUCE & QUIGG, LLP 1300 EYE STREET NW SUITE 400 EAST TOWER WASHINGTON, DC 20005			ART UNIT 1621	PAPER NUMBER DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NOVAK DRUCE DC
DOCKETED
DATE: 11/15/06
BY: JF

Office Action Summary	Application No. 11/007,312	Applicant(s) HOFFMANN ET AL.
	Examiner Jennifer Y. Cho	Art Unit 1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) _____ is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date: _____.
 5) Notice of Informal Patent Application
 6) Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10 are drawn to a process of preparing an enantiomerically enriched N-protected amino acid.
- II. Claims 11-20 are drawn to a process of preparing an enantiomerically enriched N-unprotected β - amino acid.

Inventions I and II are directed to related processes of making enantiomerically enriched amino acids. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have different starting materials and make different products. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Michael Sanzo on November 26, 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Y. Cho whose telephone number is (571) 272-6246. The examiner can normally be reached on Mon-Fri from 9 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JC

JC



PAULA A. ZUCKER, PH.D.
PRIMARY EXAMINER

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